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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/895,493	07/16/1997	MAKOTO SAITO	012.P11002C	1079
43831	7590	12/20/2005	EXAMINER	
BERKELEY LAW & TECHNOLOGY GROUP 1700NW 167TH PLACE SUITE 240 BEAVERTON, OR 97006			KLIMACH, PAULA W	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/895,493

Applicant(s)

SAITO, MAKOTO

Examiner

Paula W. Klimach

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2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 156-181 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 156-181 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed on 09/19/05. The amendment filed on 09/19/05 have been entered and made of record. Therefore, presently pending claims are 156-181.

### ***Response to Arguments***

Applicant's arguments filed 09/19/05 have been fully considered and have been found persuasive. The delay in citation of the newly discovered prior art is regretted.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 156-179 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear (US 4,827,508 A) and further in view of Matyas, Jr. Et al (4,850,017).

*As per claim 156*, the limitation of controlling copyrights of digital data: disclosed by Shear (Column 3, lines 63-68, Column 4, lines 1-2, and lines 12-14, Column 10, lines 15-18). Shear further discloses in one embodiment supplying to a user at least one of a plurality of encryption keys (Column 21, lines 28-38). Shear further discloses a number of functions that may be performed by the user such as browsing, printing, data transfers, copying, etc. (Column

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17, lines 30-35). Shear finally discloses decrypting encrypted information in response to a request from the user (Column 10 lines 29-32, lines 63-67). Shear is silent on data control by permit (usage or function) keys.

Although Shear discloses supplying to a user at least one of a plurality of encryption keys, Shear does not disclose the keys corresponding to at least one of different types of uses of digital data requested by the user, each of the utilization permit keys permitting only the corresponding at least one of the different types of uses of the digital data.

Matyas discloses a method and system for controlling the use of a cryptographic key at a using station by a generating station in a network of generating and using stations (abstract). The system of Matyas discloses supplying to a user at least one of a plurality of utilization permit keys that correspond only to at least one of different types of uses of the digital data requested by the user (column 8 lines 7-61). Each of the utilization permit keys permitting only the corresponding at least one of the different types of uses of the digital data (column 7 lines 57-67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use multiple keys to control access to information as in Matyas in the system of Shear. One of ordinary skill in the art would have been motivated to do this because the added system of Matyas would prevent the misuse of keys by the receiver (column 3 lines 25-27).

*As per claim 157*, the limitations of the different types of uses of digital data including display (see Shear Figure 5, element 504, Column 7, line 7), editing (i.e., modifying Column 7, line 11), (copying (Shear Column 7, line 14) and digital data transfer (i.e., telecommunication, Shear Column 7, line 11) and storage (Column 12, lines 44-47).

*As per claims 158 -159, and 161-163* the limitations of this claims differ from those of claims 156 by recitation that only predefined access tasks can be preformed and in the case of claim 158 those access task are the limiting of the tasks (e.g. transfer, storage, editing, display) to digital data only as defined by copyright control program. Shear discloses the using predefined access task (algorithms) Column 12 lines 1-2. Shear further discloses a copyright decoder (decryption) control logic (program) element 316 Figure 3 and Column 16 lines 1-28 for requested use data. Thus limiting the user to say viewing the documents (browsing) or the number of times the document can be viewed or the number of requests or tasks (use of usage keys) that the system can perform, or the type of data the user could access (digital versus analog or video or music etc.) would constitute limiting through predefined access by the copyright decoder control logic. Claims 158 -159 and 161-163 are rejected.

*As per claim 160*, the limitation of displaying a copyright control message attempts to use other than predefined commands is taught by Shear. Shear teaches the issuance of warning messages if the user contravenes security policies (i.e. no tampering with the system, Column 21 line 59). Claim 160 is rejected.

*As per claim 164*, the limitation that the copyright information includes authorship information (author or authors', that is history of the document) for the purpose of copyright royalties is disclosed by Shear (Column 6, lines 49-54). Claim 164 is rejected.

*As per claim 165*, the limitations of claims 159-163 have been addressed above. The further limitation that the copyright control program supplies the user with at least one of the plurality of utilization keys is disclosed by Shear (Column 14, lines 3-16). Shear teaches the use of the copyright control program (decoder control logic) in its role in decrypting the database and

*As per claim 166*, the limitations of claims 159-163 have already been addressed above. The additional limitation of data limited to digital data has been addressed in Fig. 1. Claim 166 is rejected.

*As per claim 167*, the limitation of a key control center Shear is silent. Matyaas discloses such a center in Figure 3. Claim 167 is rejected.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the key control center as in Maytas in the system of Shear. One of ordinary skill in the art would have been motivated to do this because when changes are made there is a central place to make the changes and therefore increase the speed of making those changes.

*As per claim 168*, the limitation of supplying a copyright control program from the key control center to the user with the at least one of the plurality of utilization permit key.

Matyas discloses transmitting the program with one of the plurality of utilization permit keys (Fig. 3).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to transmit the program and the key as in Matyas in the system of Shear. One of ordinary skill in the art would have been motivated to do this because changing the key quickly would only entail changing the information transmitted therefore making changes and therefore security easier. Claim 168 is rejected.

The limitations of claim 169, are identical to those of claims 156, with the added limitations that the uses specified in claim 156 are now specified (display edit copy storage and transfer) which have been addressed in claim 157. Claim 169 is rejected.

*As per claims 170-172*, the limitations of limiting the functions to display or edit and limiting their use to digital data are disclosed in Column 7, lines 5-14, Column 12, lines 1-2. Claims 170-172 are rejected.

*As per claim 173*, the limitation of a warning message is disclosed in Shear (Column 21, line 59). Claim 173 is rejected.

*As per claims 174-5*, the limitation of limiting the number of times digital data used see Shear claims 1 last part. Note in accordance with the teaching of Shear, limiting the number of times a function key were used would also be included. Claims 174-175 are rejected.

*As per claims 176-177*, the limitation of maintaining copyright and history information on authorship is disclosed by Shear see Column 4, lines 10-40. Claims 176-177 are rejected.

*As per claim 178*, the limitations of claims 172-176 have been discussed above, and the further limitation of supplying the copyright control program to the user with at least one key Matyas Figure 3. Claim 178 is rejected.

*As per claim 179*, the limitations of claims 172-176 have been discussed above, the further limitation with supplying the copyright control program to the user with the encrypted digital data see Matyas Figure 3. Claim 179 rejected.

**Claim 180-181** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear and Matyas as applied to claims 156-179 above, and further in view of Atalla (US 4,588,991 A).

*As per claims 180-181*, wherein the database includes a key control center for maintaining of a plurality of utilization permit keys. Atalla discloses a data distribution over a

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network (see Figure 3). Atalla further provides that the key control center and software are with the database (see figure 3).

One of ordinary skill in the art would have been motivated at the time the invention was made to have included the key control center with the database if the distribution is to be done by network because a database is a convenient method of organizing and maintaining the many keys used in the system. Claims 180-181 are rejected.


### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK  
Friday, December 09, 2005

  
Primary Examiner  
Art Unit 2135